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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,718	05/23/2001	Jiren Gu	30660/205648	2799

26959 7590 06/09/2003

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/09/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

4210

Office Action Summary	Application No.	Applicant(s)	
	09/864,718	GU, JIREN	
	Examiner	Art Unit	
	D. S. Nakarani	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Applicant's election without traverse of Group II, claims 25-43, in Paper No. 8 is acknowledged.
3. Claims 1-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35, line 4, the phrase "said porous substrate" lacks clear antecedent basis. No porous substrate has been previously recited therefore limitation cannot be understood.
6. Claims 25-27, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson et al. (U.S. Patent 4,513,036).

Thompson et al. disclose a laminate comprising paperboard substrate (10), polypropylene layer (12) and polyethylene layer (14) (Fig. 1 col. 3, lines 24-52). Thompson et al. disclose directly co-extruding polypropylene layer (12) and polyethylene layer (14) on to the paperboard substrate (10) (col. 4, lines 14-17). Thompson et al. also disclose a proportion by weight of polypropylene layer (12) (coating) to polyethylene layer (14) from about 50:50 to 75:25 (col. 3 lines 50-52). Thompson et al's polypropylene layer is deemed to penetrate into at least portion of the paperboard substrate since polypropylene layer is formed by melt extrusion on the paperboard substrate.

7. Claims 25, 26 and 28-31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rausing et al (U.S. Patent Re 27,610) for the reasons of record set forth in paragraph 10 of the Office Action mailed November 1, 2002 (Paper No. 5).

8. Claims 25-43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson et al. (U.S. Patent 4,859,511) in view of Rausing et al (U.S. Patent Re 27,610) and Osgood, Jr. et al. (U.S. Patent 4,855,187) for the reasons of record set forth in paragraph 11 of the Office Acton mailed November 1, 2002 (Paper No. 5).

9. Receipt of supplemental Information Disclosure Statement filed November 8, 2002 is acknowledged and has been made of record. All non-English references have been considered to the extent of provided English abstract and/or shown category in the International Search Report dated October 10, 2002.

10. Applicant's arguments filed February 10, 2003 have been fully considered but they are not persuasive:

In reference to rejection of claims 25-31 under 35 USC 103(a) as being unpatentable over Rausing et al (U.S. Patent Re 27,610), applicant mainly argue that the present invention requires co-extruding polypropylene layer on cellulosic substrate so that the molten polypropylene layer is adjacent the surface of the substrate and is sandwiched between the substrate and the second polymer layer. Rausing et al laminate polypropylene layer to paper such that polyethylene inner layer is directly bonded to the paper and the polypropylene layer is an intermediate layer between two polyethylene layers. Rausing et al. do not teach co-extruding the polymer layers onto the substrate.

These arguments are unpersuasive because the broadly claimed invention is inclusive of additional layers. The co-extrusion is a process step and bears no-patentable weight in determination of patentability of the product unless shown that the laminate of present invention is different than the prior art product made by lamination.

In reference to rejection of claims 25-43 under 35 USC 103(a) as being unpatentable over Patterson et al. in view Rausing et al and Osgood, Jr. et al., applicant mainly argue that none of the references teach cellulosic substrate coated with claimed polymer layers by co-extrusion process. Further applicant state that the references individually do not teach claimed invention and there is no motivation to combine these references. There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modifications.

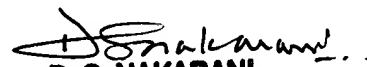
These arguments are unpersuasive because the coating by co-extrusion process is a process step. In determination of patentability of product, process bears no patentable weight. Furthermore prior art teach coating paper substrate by extrusion. Therefore forming multilayer by co-extrusion is an obvious process. There is nothing on record showing that the product made by co-extrusion process is different than the product made by heat and pressure lamination.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D.S. Nakarani whose telephone number is 703-308-2413. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

D. S. Nakarani/mn
June 8, 2003


D. S. NAKARANI
PRIMARY EXAMINER